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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,103	09/17/2003	Russell L. Gillenwater	16356.831	3694
27683	7590	02/15/2006	EXAMINER	
HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202				DUNCAN, MARC M
ART UNIT		PAPER NUMBER		
		2113		

DATE MAILED: 02/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/664,103	GILLENWATER ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Marc Duncan	2113

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 08 November 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-60 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 17 September 2004 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_ .
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Status of the Claims***

Claims 1-10, 21-30 and 41-50 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,691,253 B1 to Gillenwater et al.

Claims 11-20, 31-40 and 51-60 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11-20 of U.S. Patent No. 6,691,253 B1 to Gillenwater et al.

### ***Double Patenting***

The non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper time wise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10, 21-30 and 41-50 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,691,253 B1 to Gillenwater et al. Claims 11-20, 31-40 and 51-60 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11-20 of U.S. Patent No. 6,691,253 B1 to Gillenwater et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because it is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA 1963).

Claim 1 of U.S. Patent No. 6,691,253 teaches the following:

A method of performing high-speed software downloads to and diagnostics testing of a target computer system in a manufacturing environment, the method comprising:

booting the target computer system to a multi-tasking operating system ("OS");

launching a step sequencing engine application;

the step sequencing engine application simultaneously launching a diagnostics platform and a software download manager;

the diagnostics platform initiating a plurality of diagnostics tests to be performed on the target computer system and the software download manager simultaneously launching a software download tool for downloading customer software to a hard drive of the target computer system; and

upon completion of the diagnostics tests and the customer software downloading, rebooting the target computer system to DOS.

Claim 1 of the instant application does not teach:

upon completion of the diagnostics tests and the customer software downloading, rebooting the target computer system to DOS.

Applicant has clearly removed elements from a patented claim along with their respective function as an obvious expedient.

The rejection of instant claim 1 above is representative of the rejections of instant claims 2-10 of the instant application with respect to claims 2-10 of the Gillenwater patent. The same limitation shown above with respect to claim 1 has been removed from each of patented claims 2-10 along with its respective function as an obvious expedient.

Claim 21 of the instant application does not teach:

rebooting the target system to DOS.

Applicant has clearly removed elements from a patented claim along with their respective function as an obvious expedient.

The rejection of instant claim 21 above is representative of the rejections of instant claims 22-30 of the instant application with respect to claims 2-10 of the Gillenwater patent. The same limitation shown above with respect to claim 1 has been removed from each of patented claims 2-10 along with its respective function as an obvious expedient. Claims 22-30 teach rebooting the target computer system, but do not specify rebooting to DOS.

Claim 41 of the instant application does not teach:

rebooting the target computer system to DOS.

Applicant has clearly removed elements from a patented claim along with their respective function as an obvious expedient.

The rejection of instant claim 41 above is representative of the rejections of instant claims 42-50 of the instant application with respect to claims 2-10 of the Gillenwater patent. The same limitation shown above with respect to claim 1 has been removed from each of patented claims 2-10 along with its respective function as an obvious expedient. The instant claims teach rebooting to a non-multi-tasking operating system, but do not specifically teach that non-multi-tasking operating system being DOS. DOS is a non-multi-tasking operating system and is thus encompassed by the instant claim.

Claim 11 of U.S. Patent No. 6,691,253 teaches:

A system for enabling the performance of high-speed software downloads to and diagnostics testing of a target computer system in a manufacturing environment, the system comprising:

means for booting the target computer system to a multi-tasking operating system ("OS");

means for launching a step sequencing engine application for simultaneously launching a diagnostics platform and a software download manager;

wherein the diagnostics platform initiates a plurality of diagnostics tests to be performed on the target computer system and the software download manager simultaneously launches a software download tool for downloading customer software to a hard drive of the target computer system; and

means for rebooting the target computer system to DOS upon completion of the diagnostics tests and the customer software downloading.

Claim 11 of the instant application does not teach:

means for rebooting the target computer system to DOS upon completion of the diagnostics tests and the customer software downloading.

Applicant has clearly removed elements from a patented claim along with their respective function as an obvious expedient.

The rejection of instant claim 11 above is representative of the rejections of instant claims 12-20 of the instant application with respect to claims 12-20 of the Gillenwater patent. The same limitation shown above with respect to claim 11 has been

removed from each of patented claims 12-20 along with its respective function as an obvious expedient.

Claim 31 of the instant application does not teach:

means for rebooting the target system to DOS.

Applicant has clearly removed elements from a patented claim along with their respective function as an obvious expedient.

The rejection of instant claim 31 above is representative of the rejections of instant claims 32-40 of the instant application with respect to claims 12-20 of the Gillenwater patent. The same limitation shown above with respect to claim 31 has been removed from each of patented claims 12-20 along with its respective function as an obvious expedient. Claims 32-40 teach rebooting the target computer system, but do not specify rebooting to DOS.

Claim 51 of the instant application does not teach:

means for rebooting the target computer system to DOS.

Applicant has clearly removed elements from a patented claim along with their respective function as an obvious expedient.

The rejection of instant claim 51 above is representative of the rejections of instant claims 52-60 of the instant application with respect to claims 12-20 of the Gillenwater patent. The same limitation shown above with respect to claim 51 has been removed from each of patented claims 12-20 along with its respective function as an

obvious expedient. The instant claims 52-60 teach rebooting to a non-multi-tasking operating system, but do not specifically teach that non-multi-tasking operating system being DOS. DOS is a non-multi-tasking operating system and is thus encompassed by the instant claim.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Duncan whose telephone number is 571-272-3646. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Beausoliel can be reached on 571-272-3645. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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